

## **REMARKS**

Applicants respectfully request entry of this Amendment and reconsideration of the Office Action mailed September 19, 2006. Applicants also respectfully request a three month extension of time. The Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees.

### **I. General Remarks Regarding the Content of this Amendment**

Upon entry of this Amendment, claims 1, 2, 4-38, 40-60 and 68-76 will remain pending in this application. Independent claim 48 has been amended to include subject matter directed to the configuration of the wear elements, as shown in Figure 13 and claim 55 has been amended to include language consistent with that of claim 48. Other minor editorial amendments have been made to certain claims. Claims 56-60 have been withdrawn from consideration pursuant to a Restriction Requirement. Claims 3, 39 and 61-67 have been cancelled without prejudice or disclaimer. Accordingly, no new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

### **II. Applicants' Claims Patentably Distinguish from the Cited Art**

#### **A. Claims 1, 4-11, 15, 16, 20-28, 33, 34 and 36 Patentably Distinguish from Cheng '762**

The Office rejected claims 1, 4-11, 15, 16, 20-28, 33, 34 and 36 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,938,762 to Cheng (hereinafter "Cheng '762"). *See* the Office Action at page 2. Applicants respectfully traverse this rejection and request reconsideration.

The filing date of the Cheng '762 reference is May 28, 2003. With respect to claims 1, 4-11, 15, 16, 20-28, 33, 34 and 36, Applicants rely on the Declaration of the inventors under 37 C.F.R. § 1.131 filed in the present matter concurrently herewith, to establish a date of conception and reduction to practice prior to May 28, 2003, the filing date of the Cheng '762 reference. Based on the 37 C.F.R. § 1.131 Declaration of the inventors, Applicants antedate the filing date of Cheng '762. Accordingly, Cheng '762 is not prior art. Applicants respectfully request withdrawal of this rejection.

**B. Claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, 34 and 36 Patentably Distinguish from Cheng '362**

The Office rejected claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, 34 and 36 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,386,362 to Cheng (hereinafter "Cheng '362"). *See* the Office Action at page 2. Applicants respectfully traverse this rejection and request reconsideration.

Independent claims 1 and 20 recite, among other features, "[a] golf bag comprising...a base secured to the second end of the body, the base including a *one-piece element that extends substantially around the second end of the body.*" (Emphasis added). Cheng '362 fails to teach or suggest a base having a one-piece element.

Cheng '362 describes a golf bag including a base seat. Col. 2, lines 43-45. The base seat includes a front section, a rear section and a pivot section connected between the front and rear sections. Col. 2, lines 65-67. Cheng '362 fails to teach or suggest a base including a one-piece element extending substantially around the second end of the body. Rather, Chang '362 describes a multi-part base having a connecting portion that is formed of a flexible material to facilitate bending of the base. Col. 3, lines 17-20. Therefore, Cheng '362 clearly fails to teach or suggest all the features of independent claims 1 and 20.

Dependent claims 6, 8-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-25, 33, 34 and 36 that depend from claim 20, are also allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein. Applicants respectfully request withdrawal of these rejections.

**C. Claims 1, 4, 6-11, 15, 16, 18, 20-28, 33, 34 and 36 Patentably Distinguish from Te-Pin**

The Office rejected claims 1, 4, 6-11, 15, 16, 18, 20-28, 33, 34 and 36 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,568,527 to Te-Pin (hereinafter "Te-Pin"). *See* the Office Action at page 3. Applicants respectfully traverse this rejection and request reconsideration.

As discussed above, independent claims 1 and 20 recite, among other features, a golf bag including a base, the base including a *one-piece element that extends substantially around the*

*second end of the body.* Applicants respectfully assert that Te-Pin fails to teach or suggest these features.

Te-Pin describes a golf bag that includes a base bracket. Col. 2, lines 48-49. The base bracket includes a front section, a rear section, a first flexible section disposed on the front section, a second flexible section disposed on the rear section and a connecting member connected between the first and second flexible sections. *See* Col. 2, lines 57-61 and FIGS. 1, 2, 4 and 5. The connecting member is disposed between the first and second flexible sections and is connected with outer edges of corresponding portions thereof. Col. 3, lines 33-35. A part of the connecting member is connected with the first and second flexible sections on the bottom of the base bracket, while another part is connected with the first and second flexible sections on the lateral side of the base seat. Col. 3, lines 35-40. The first and second sections are “connected together to form a larger receiving space.” Col. 3, lines 40-41.

Clearly, Te-Pin fails to teach or suggest a base including a one-piece element that extends substantially around the second end of the body. In fact, Te-Pin describes a base including multiple parts connected together. For instance, the connecting member of Te-Pin is “bridged and connected between the first and second flexible sections by way of stitching.” Col. 4, lines 15-17. Note also Figs. 2, 4 and 5 of Te-Pin. As such, Te-Pin specifically teaches away from a one-piece element that extends substantially around the second end of the body, as recited in claims 1 and 20. Applicants respectfully assert that independent claims 1 and 20 patentably distinguish from Te-Pin and request withdrawal of this rejection.

Claims 4, 6-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-28, 33, 34 and 36 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein. Applicants respectfully request withdrawal of these rejections.

**D. Claims 1, 4, 7-11, 15, 16, 18, 20-24, 25-27, 33, 34 and 36 Patentably Distinguish from Cheng ‘937**

The Office rejected claims 1, 4, 7-11, 15, 16, 18, 20-27, 33, 34 and 36 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,564,937 to Cheng (hereinafter “Cheng ‘937”). *See* the Office Action at page 3. Applicants respectfully traverse this rejection and request reconsideration.

As discussed above, independent claims 1 and 20 recite, among other features, a golf bag including a base, the base including a *one-piece element that extends substantially around the second end of the body*. Applicants respectfully assert that Cheng '937 fails to teach or suggest such features.

Cheng '937 describes a golf bag including a base having a front section and a rear section. Col. 3, lines 3-4. The bottom of the front section is open and a driving board is connected to the front section via a connecting structure. Col. 3, lines 12-31. The golf bag base of Cheng '937 includes multiple parts. *See* FIGS. 2 and 3. Clearly, Cheng '937 fails to teach or suggest a one-piece element that extends substantially around the second end of the body. Accordingly, Applicants assert that independent claims 1 and 20 patentably distinguish from Cheng '937.

Claims 4, 7-11, 15, 16 and 18 that depend from claim 1, as well as claims 21-27, 33, 34 and 36 that depend from claim 20, are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.

**E. Claims 2, 3, 29, 30, 38-43, 46 and 47 Patentably Distinguish from the Combination of Cheng '762, Cheng '362, Cheng '937, or Te-Pin with Kang or Nelson**

The Office rejected claims 2, 3, 29, 30, 38-43, 46 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Cheng '762, Cheng '362, Cheng '937 or Te-Pin in view of U.S. Patent Publication No. 2004/0200746 to Kang (hereinafter "Kang") or U.S. Patent No. 3,941,398 to Nelson (hereinafter "Nelson"). Applicants respectfully traverse these rejections and request reconsideration.

Claims 2-3 and 29-30 depend from claims 1 and 20, respectively. As discussed above, none of the Cheng references or Te-Pin teaches or suggests all the features of claims 1 and 20. The addition of Kang or Nelson fails to cure the deficiencies of the Cheng references or the Te-Pin reference with respect to claims 1 and 20. Accordingly, Applicants respectfully assert that claims 2, 3, 29 and 30 are allowable for at least the same reasons as their respective base claims and further in view of the novel features recited therein.

Independent claim 38 recites features similar to those recited in claims 1 and 20. For example, claim 38 recites, among other features, "[a] golf bag comprising: ...a base secured to

the second end of the body, the base including a one-piece element that extends substantially around the second end of the body ....” None of Cheng ‘762, Cheng ‘362, Cheng ‘937 or Te-Pin teaches or suggests the features of claim 38. For instance, none of the cited references, alone or in combination, teach or suggest a one-piece element that extends substantially around the second end of the body. The addition of Kang or Nelson fails to cure the deficiencies of these references with respect to claim 38 because neither Kang nor Nelson, alone or in combination teaches or suggests this one-piece element. Accordingly, Applicants respectfully assert that claim 38 is allowable over the cited references.

Claims 40-43, 46 and 47 that depend from claim 38 are allowable for at least the same reasons at discussed above and further in view of the novel features recited therein. Applicants respectfully request withdrawal of this rejection.

**F. Claims 12-14, 31, 32, 35-37, 44, 45 and 48-55 Patentably Distinguish from the Combination of Cheng ‘762, Cheng ‘362, Cheng ‘937, or Te-Pin with Hamamori or Wen Chien**

The Office rejected claims 12-14, 31, 32, 35-37, 44, 45 and 48-55 under 35 U.S.C. § 103(a) as being unpatentable over Cheng ‘762, Cheng ‘362, Cheng ‘937 or Te-Pin in view of U.S. Patent No. 6,648,137 to Hamamori (hereinafter “Hamamori”) or U.S. Patent No. 6,298,988 to Wen-Chien (hereinafter “Wen-Chien”). Applicants respectfully traverse these rejections and request reconsideration.

Claims 12-14 that depend from claim 1, as well as claims 31, 32 and 35-37 that depend from claim 20, and claims 44 and 45 that depend from claim 38, are allowable for at least the same reasons as their respective base claims. The addition of Hamamori or Wen-Chien fails to cure the deficiencies of the Cheng references and Te-Pin with respect to independent claims 1, 20 and 38. Accordingly, Applicants respectfully assert that dependent claims 12-14, 31, 32, 35-37, 44 and 45 are allowable over the cited combination of references.

Independent claim 48 has been amended to recite, among other features, a golf bag comprising:

a base secured to an end of the body, the base having a foam element formed of a polymer foam material, and the base having at least a first wear element and a second wear element secured to an exterior surface of the foam element, wherein *the first wear element has a first configuration and the second wear element has a*

*second configuration, the second configuration being different from the first configuration* and wherein at least one of the first and second wear elements is configured to contact a ground.

None of the Cheng references or Te-Pin teaches or suggests the features of claim 48. For example, none of the Cheng references or Te-Pin teaches or suggests at least a first and second wear element. The addition of Hamamori or Wen-Chien fails to cure the deficiencies of the Cheng references or Te-Pin with respect to claim 48. Neither Hamamori nor Wen-Chien, alone or in combination with the other cited references, teaches or suggests a first wear element and a second wear element having different configurations. Rather, Hamamori describes a golf bag having L-shaped supporting leg members that have a uniform appearance and are arranged about the perimeter of the bottom surface of the base of the golf bag. *See* Col. 3, lines 45-51 and FIGS. 1, 2, 4 and 8. Hamamori fails to teach or suggest elements of differing configurations.

Wen-Chien fails to teach or suggest at least a first and second wear element having different configurations. Wen-Chien describes a golf bag having a base with contact blocks. Col. 1, line 51 – Col. 2, line 4. The contact blocks of Wen-Chien are arranged about the perimeter of the base of the golf bag and are generally uniform in configuration. *See* FIGS. 2 and 3. Wen-Chien clearly fails to teach or suggest wear elements of differing configurations.

Accordingly, Applicants respectfully assert that independent claim 48, as well as claims 49-55 that depend therefrom, are allowable for at least the reason cited above.

**G. Claims 17-19 and 61-76 Patentably Distinguish from the Combination of Cheng ‘762, Cheng ‘362, or Cheng ‘937 with Any One of JP ‘250, Nevard and Yoshida**

The Office rejected claims 17-19 and 61-76 under 35 U.S.C. § 103(a) as being unpatentable over Cheng ‘762, Cheng ‘362 or Cheng ‘937 in view of Japanese Patent No. 198250 (hereinafter “JP ‘250”), U.S. Patent No. 3,866,646 to Nevard (hereinafter “Nevard”) or U.S. Patent No. 6,736,264 to Yoshida (hereinafter “Yoshida”). Applicants respectfully traverse these rejections and request reconsideration.

Claims 17-19 depend from claim 1. The addition of JP ‘250, Nevard and/or Yoshida fails to cure the deficiencies of the Cheng references with respect to claim 1. For instance, none of JP ‘250, Nevard or Yoshida teaches or suggests a base including a one-piece element that extends substantially around the second end of the body. Accordingly, Applicants assert that claims 17-

19 are allowable for at least the same reasons as their base claim and further in view of the novel features recited therein.

Claims 61-67 have been cancelled, thereby rendering this rejection moot.

Independent claim 68 recites, among other features, a golf bag comprising a frame formed as a single shaft that extends between the first end and the base, the frame including a first curved area positioned proximal the first end to form a handle, and the frame including a *separate second curved area* positioned proximal the second end. Applicants respectfully assert that none of JP '250, Nevard or Yoshida, either alone or in combination with the other cited references, teaches or suggests a frame including a first curved area and a second curved area. Rather, each of JP '250, Nevard and Yoshida describe a shaft having, at most, a single curved area near an upper portion of the shaft. None of the references teaches or suggests a second curved area positioned proximal the second end. Accordingly, Applicants assert that independent claim 68 is allowable over the cited combination of references.

Claims 69-76 that depend from claim 68 are allowable for at least the same reason discussed above and further in view of the novel features recited therein. Applicants respectfully request withdrawal of this rejection.

**H. Claim 48 Patentably Distinguishes from the Combination of Nelson with Hamamori or Wen-Chien**

The Office rejected claim 48 as being unpatentable over U.S. Patent No. 3,941,398 to Nelson (hereinafter "Nelson") in view of Hamamori or Wen-Chien. Applicants respectfully traverse this rejection and request reconsideration.

Neither Nelson, Hamamori nor Wen-Chien, alone or in combination, teaches or suggests the features of claim 48. For instance, none of Nelson, Hamamori or Wen-Chien teaches or suggests at least a first and second wear element having different configurations. Rather, Nelson describes an apparatus for transporting golf clubs. Abstract. The golf club holder includes reinforcing means including a base and elongate braces extending along the outside of the body. Nelson fails to teach or suggest any wear elements arranged on the base, let alone wear elements having different configurations. The addition of Hamamori or Wen-Chien fails to cure the deficiencies of Nelson with respect to claim 48 for the reasons described above. Accordingly, Applicants assert that claim 48 is patentably distinct from the cited combination of references.

**I. Claims 48 and 54 Patentably Distinguish from the Combination of Nelson or Kang with Hamamori**

The Office rejected claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Nelson or Kang in view of Hamamori. Applicants respectfully traverse this rejection and request reconsideration.

Neither Nelson nor Kang teaches or suggests at least a first and second wear element having different configurations, as recited in claim 48. Both Nelson and Kang describe bottom elements having a uniform configuration. Neither Nelson nor Kang, alone or in combination with Hamamori, teach or suggest the recited features of claim 48. Accordingly, Applicants respectfully assert that claim 48, and claim 54 that depends from claim 48, are allowable.

**J. Claims 68-71 Patentably Distinguish from Yoshida**

The Office rejected claims 61, 62 and 65-71 under 35 U.S.C. § 102(b) as being anticipated by Yoshida. Applicants respectfully traverse this rejection and request reconsideration.

Claims 61, 62 and 65-67 have been cancelled, thereby rendering the rejection of these claims moot.

As discussed above, Yoshida fails to teach or suggest all the features of independent claim 68. Claim 68 recites, among other features, a golf bag comprising a frame formed as a single shaft that extends between the first end and the base, the frame including a first curved area positioned proximal the first end to form a handle, and the frame including a *separate second curved area* positioned proximal the second end. Yoshida fails to teach or suggest such an arrangement.

Rather, Yoshida describes, at most, a shaft having a single curved portion. *See* FIG. 9. The shaft of Yoshida includes a straight portion that runs downward from the curved portion. Yoshida fails to teach or suggest a second curved portion proximal to the second end. Accordingly, Applicants assert that claim 68, as well as claims 69-71 that depend therefrom, are allowable.

**K. Claim 68 Patentably Distinguishes from Nevard or the Combination of Nevard with Dage**



The Office rejected claim 68 under 35 U.S.C. § 102(b) as being anticipated by Nevard, or, in the alternative under 35 U.S.C. § 103(a) as being unpatentable over Nevard in view U.S. Design Patent No. D374,986 to Dage (hereinafter “Dage”). Applicants respectfully traverse this rejection and request reconsideration.

As discussed above, Nevard fails to teach or suggest all the features of claim 68. For instance, Nevard describes, at most a single curved portion. Nevard fails to teach or suggest a second curved portion. *See* FIG.1. The addition of Dage fails to cure the deficiencies of Nevard with respect to claim 68. Accordingly, Applicants assert that claim 68 is patentably distinct from the cited references.

**L. Claims 68-70 Patentably Distinguish from Lee**

The Office rejected claims 68-70 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,314,063 to Lee et al. (hereinafter “Lee”). Applicants respectfully traverse this rejection and request reconsideration.

Independent claim 68 recites, among other features, a golf bag comprising a frame formed as *a single shaft* that extends between the first end and the base, the frame including a first curved area positioned proximal the first end *to form a handle*, and the frame including a separate second curved area positioned proximal the second end. Lee describes a golf bag frame including a plurality of straight shaft sections and elbows. *See* FIGS. 4 and 5. The Office cites portion 46 as constituting the “first curved area” of claim 68. Applicants respectfully disagree. Portion 46 is an elbow. Applicants submit that given the configuration of an elbow sized to form the frame of a golf bag, the elbow could not constitute a handle simply due to the size and configuration of the elbow. A person of ordinary skill in the art would not be motivated to use an elbow of the size indicated in Lee to form a handle for a person large enough and strong enough to carry a golf bag since the size of that person’s hand would be far too large to fit around an elbow. Accordingly, Applicants assert that claim 68, as well as claims 69 and 70 that depend therefrom, are allowable.

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner believe that a telephonic or in-person interview would aid in prosecution of this matter, Applicants urge Examiner to contact the undersigned attorney.

Please charge all fees in connection with this communication to Deposit Account No. 19-0733.

Respectfully submitted,

Date: March 19, 2007

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